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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,145	09/22/2003	J. Troy Weeks	058951-0172	9031

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EXAMINER	
MCCORMICK EWOLDT, SUSAN BETH	
ART UNIT	PAPER NUMBER
1661	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,145	WEEKS ET AL.	
	Examiner	Art Unit	
	S. B. McCormick-Ewoldt	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-53* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 13 (in part), 36 (in part) and 37, drawn to a method for producing a transgenic plant; including the use of SEQ ID NO:12, classified in class 800, subclass 278, for example.

II. Claims 13(in part), 15, 36 (in part) and 37, drawn to a method for producing a transgenic plant; including the use of SEQ ID NO:14, classified in class 435, subclass 468, for example.

III. Claims 13(in part), 16, 36 (in part) and 37, drawn to a method for producing a transgenic plant; including the use of SEQ ID NO:15, classified in class 435, subclass 419, for example.

Groups I-III are linked by claims 1-12, 14, 17-35 and 38-45.

IV. Claims 46-47, drawn to a nucleic acid comprising SEQ ID NO.: 12, classified in class 536, subclass 23.1, for example.

V. Claims 48-49, drawn to a nucleic acid comprising SEQ ID NO.: 14, classified in class 536, subclass 23.1, for example.

VI. Claims 50-51, drawn to a nucleic acid comprising SEQ ID NO.: 15, classified in class 536, subclass 23.1, for example.

VII. Claims 52-53, drawn to a protein comprising an amino acid sequence at least 80% identical to SEQ ID NO.: 13, classified in class 530, subclass 350, for example.

Inventions IV-VI are related to inventions I-III as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case each nucleotide sequence can be used for a

materially different process, for example, the nucleic acids could be used to make recombinant protein in *E.coli*.

Inventions I-III are drawn to methods that utilize different nucleic acids, and inventions IV-VI are drawn to different nucleic acids. Each of these are patentably distinct from each other because the nucleic acids are each unique with different chemical and structural features. Applicants are reminded that nucleic acid sequences encoding different proteins, and the amino acid sequences they encode, are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleic acid and amino acid sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Inventions I-VI are patentably distinct from invention VII. The proteins of invention VII can be made without the method of inventions I-III or the nucleic acids of inventions IV-VI. For example, the protein of the invention VII could be purified from extracts of Aspergillus, Cladosporium, penicillium or myrothecium.

If Applicant elects one of the inventions from groups I-VI then Applicant is required to select one nucleic acid or amino acid sequence from the following: SEQ ID NO: 12, 14 and 15. Claims that do not read on the elected sequence will be considered withdrawn. Applicant is advised that a reply to this requirement must include an identification of the sequence that is selected. An election that does not identify the sequence selected will be considered nonresponsive. This requirement is not to be construed as an election of species since each nucleotide sequence is not a member of a single genus of invention but constitutes independent and patentably distinct inventions.

Claims 1-12, 14, 17-35 and 38-45 link the inventions of Groups I-III. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 14, 47, 49 and 51-53. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to

examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant applications. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the Examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Election of Species

This application contains claims directed to the following patentably distinct species: a) an agent that enhances transformation efficiency wherein the agent is a purine inhbitor or a pyrimidine inhibitor or a purine inhbitor and a pyrimidine inhibitor. The species listed in a) are independent or distinct because an agent that enhances transformation efficiency comprise different uses. For example, cyclophosphamide is used to treat cancer and leflunomide is used to treat rheumatoid arthritis. Therefore, the species are independent and patentable over one another.

If Applicant selects one of inventions I-III for prosecution then Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e. elect one purine inhbitor or a pyrimidine inhibitor agent listed i.e. mizoribine, azathioprine, mycophenolic acid, mycophenolate mofetil, 5-fluorouracil, Brequinar sodium, leflunomide, azaserine, acivicin, methotrexate, methotraxate polyglutamate derivatives or cyclophosphaminde) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2-4 and 39-40 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the

prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER